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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,070

01/09/2006

Matthias Hauser

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EXAMINER

LOVE, TREVOR M

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

05/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,070	Applicant(s) HAUSER ET AL.	
	Examiner TREVOR M. LOVE	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-8,10-12,14-17 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-8,10-12,14-17 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement is made to Applicant's response filed 02/25/2009.

Claims 1, 3, 6-8, 10-12, 14-17, and 23-31 are currently pending and under consideration.

All rejections of record not set forth or restated herein are to be considered withdrawn.

Claim Objections

Claim 1 is objected to because of the following informalities: the claim recites the phrase "...until used as a consumer as said cosmetic...". It is the position of the Examiner that "as" was intended to be "by" and for the purpose of compact prosecution, will be interpreted as such. Appropriate correction is required.

Claim 6 is objected to because of the following informalities: the claim recites the phrase "...wherein the fatty acid mono-, di-, or triglycerides wherein the fatty acids contain...". It is the position of the Examiner that the phrase "wherein the fatty acids" was intended to be deleted. For the purpose of compact prosecution, the claim is being interpreted as reading "...wherein the fatty acid mono-, di-, or triglycerides contain...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 6-8, 10-12, 14-17, and 23-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the phrase "...comprises at least one oil or wax component comprising (a) at least 70% w/w of C₁₂-C₂₄ fatty acid mono-, di-, or triglyceride; (b) from about 1 to about 40% w/w of C₁₂-C₅₀ fatty alcohols; and (c) from about 1 to about 30% w/w of C₁₄-C₄₀ fatty acid..." It is unclear whether Applicant is intending to claim an oil component which can be any oil component and a wax component with specific limitations, or if Applicant is intended to claim that said oil component has the same limitations that said wax component has. It is further unclear whether said limitations on said wax component are all present at the same time, or if the limitations are in the alternative. Based on the fact that the upper limit of limitation (b) can not be present when the lower limit of limitation (a) is present, and for the purpose of compact prosecution, claim 1 will be interpreted as requiring either the presence of any oil component or the presence of a wax component which comprises any one of (a), (b), and (c).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6-8, 10-12, 14-17, and 23-31 are rejected under 35 U.S.C. 102(b) as being anticipated by McAtee et al (U.S. Patent 6,153,208).

With regard to **instant claim 1**, McAtee discloses a substantially dry, disposable, personal cleansing article useful for both cleansing the skin or hair (see abstract). Said cleansing article comprises a substrate, a surfactant phase, and a lipid phase (see examples 1-5). Said lipid phase comprises hardening materials. Said hardening materials are selected from fatty acid esters such as mono-, di-, or triglycerides (see column 32, lines 21 and 49-50), animal based fats and oils and vegetable oils, such as **hydrogenated castor oil** or **hydrogenated rapeseed oil** (see column 32, lines 21, 58, and 67, and column 33, lines 3-4), fatty acids having from about 10 to 40 carbon atoms, such as triglycerides or diglycerides (see column 32, lines 22-23 and column 33, lines 47-48), fatty alcohols such as **cetyl alcohol** and **behenyl alcohol** (see column 32, lines 20, 34-48, and claim 10), and alpha-hydroxy fatty acids and fatty acids having from about 10 to about 40 carbon atoms, such as **behenic**, **euric**, **stearic**, and **lauric** acids (see column 32, line 22 and column 33, lines 12-16). Said hardening components are taught as being present in the McAtee in a range of about 0.1% to about 99.9%, and more preferably about 2% to about 25% of the conditioning component (see column 32, lines 1-7). In one of the preferred embodiments of McAtee, the lipid phase comprises at least two components that could be considered active agents, specifically, vitamin E acetate and tribehenin (see column 52, lines 36-38). Said hardening materials have a melting point between 30° and 250° C, and more preferably between about 37° and about 80° C (see column 32, lines 8-12). McAtee teaches that the lipid phase is present

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in an amount ranging from 0.10 to 0.35 weight percent (see examples 1-5, table bridging column 52 and 53).

With regard to the limitation in instant claim 1 that requires the aqueous phase to be present in an amount from about 1 to about 10 grams per 1 gram substrate, McAtee teaches that the surfactant in the aqueous phase is present as 0.5 to 12.5% of the substrate (see column 18, lines 24-28), wherein it is further taught that said surfactants are present as approximately 13% of said aqueous phase (see examples 1-5, table bridging column 52 and 53). Therefore, said aqueous phase is in a ratio of about 1:1 with the substrate.

With regard to the dependent claims, McAtee discloses that said hardening materials have a melting point between 30° and 250° C, and more preferably between about 37° and about 80° C (see column 32, lines 8-12), this anticipates **instant claim 3**. Said hardening materials are selected from fatty acid esters such as mono-, di-, or triglycerides (see column 32, lines 21 and 49-50), animal based fats and oils and vegetable oils, such as hydrogenated castor oil or hydrogenated rapeseed oil (see column 32, lines 21, 58, and 67, and column 33, lines 3-4), fatty acids having from about 10 to 40 carbon atoms, such as triglycerides or diglycerides (see column 32, lines 22-23 and column 33, lines 47-48), fatty alcohols such as cetyl alcohol and behenyl alcohol (see column 32, lines 20, 34-48, and claim 10), and alpha-hydroxy fatty acids and fatty acids having from about 10 to about 40 carbon atoms, such as behenic, euric, stearic, and lauric acids (see column 32, line 22 and column 33, lines 12-16), these anticipate **instant claims 6, 7, 10-11, 13-15** respectively. Said hardening components

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are taught as being present in the McAtee in a range of about 0.1% to about 99.9%, and more preferably about 2% to about 25% of the conditioning component (see column 32, lines 1-7), this reads on **instant claims 8, 12, 16**. McAtee also teaches that the lipid phase can comprise 10% petrolatum, 5% tribehenin, 2% vitamin E acetate, 3% synthetic beeswax, 9% polyethylene wax, and 0% water, these anticipate **instant claim 24** (see column 53, lines 33-42). Furthermore, component (a) can alternatively be a C8-C30 dialkyl ether (see column 25, line 47 through column 26, line 5, particularly noting petrolatum in line 58, and di C8-C30 alkyl ether in line 5), this anticipates **instant claim 17**. In one of the preferred embodiments of McAtee, the lipid phase comprises at least two components that could be considered active agents, specifically, vitamin E acetate and tribehenin (see column 52, lines 36-38). McAtee also discloses that the active can be a sunscreen (see column 47, line 26 through 65), this anticipates **instant claim 26**. Furthermore, vitamin E acetate, also known as tocopheryl acetate, is taught as a non-steroidal cosmetic soothing agent which is useful for treating inflammation of the skin (see column 44, lines 7-9 and 65), this anticipates **instant claim 23**. McAtee also teaches the addition of thickeners (see column 29, lines 44-55), this anticipates **instant claim 25**. The product of McAtee is taught as being flat, thick, circle, square, rectangular or oval pads (see column 15, lines 47-60), this anticipates **instant claim 27**. McAtee further discloses that the lipid and aqueous phases can be added sequentially in any order (see column 50, lines 22-24), this anticipates **instant claims 29-30**. The aqueous and lipid phases are taught as being applied by spraying methods (see column 55, lines 24-26), this anticipates **instant claim 31**.

With regard to **instant claim 28**, McAtee teaches that the device disclosed can comprise more than two layers (see column 9, lines 26-28). Furthermore, it is well known in the art when marketing a single use hygiene device to package the device.

Applicant's Arguments

Applicant argues in the response filed 02/25/2009 that there is no teaching or suggesting of the specific lipid phase and aqueous phase recited by the instant claims, or that said lipid phase comprises less than 10% water. Applicant also argues that there is no teaching or suggestion in McAtee that the lipid phase should be insoluble in the aqueous phase, or that said composition should not form a single phase until used by a consumer.

Response to Arguments

Applicant's arguments have been fully considered and are not found persuasive. Applicant's argument that McAtee fails to teach the lipid and aqueous phases of the instant claims is not found persuasive since as can be seen by examples 1-5, the composition of McAtee comprises both an aqueous and a lipid phase, wherein said lipid phase does not have water taught as one of the components (see table under III. in column 53). Applicant's argument with regard to the solubility, or lack thereof, of the lipid phase in the aqueous phase is not found persuasive since a lipid phase comprises similar, if not the same components as Applicant's lipid phase, and therefore, absent evidence to the contrary, would have similar properties such as insolubility in an aqueous phase.

Double Patenting***Non-Statutory Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 6-8, 10-12, 14-17, and 23-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 6-8, 10-12, 14-17, and 23-31 of copending Application No. 10/520,952. Although the conflicting claims are not identical, they are not patentably distinct from each other, particularly since copending claims 1, 3, 6-8, 10-12, 14-17, and 23-31 anticipate instant claims 1, 3, 6-8, 10-12, 14-17, and 23-31.

Both the copending claims and the instant claims teach that the product can be a puff, pad, sponge, cotton ball, swab, brush, glove, mitt, or bar. Even though the instant

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claims are broader than the claims of copending '952, copending claims 1, 3, 6-8, 10-12, 14-17, and 23-31 anticipate instant claims 1, 3, 6-8, 10-12, 14-17, and 23-31 because the specified products taught by both sets of claims include puffs, pads, sponges, cotton balls, swabs, brushes, mitts, or bars are made of the same liquid and aqueous phase materials. Further, the scope of copending claim 1 is a species of the genus instant claim 1. Copending claim 1 therefore anticipates instant claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3, 6-8, 10-12, 14, 16-17, 23-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20, 22-24, and 26-27 of copending Application No. 10/520,970. Although the conflicting claims are not identical, they are not patentably distinct from each other, particularly since the copending claims anticipate the instant claims.

The instant claims are broader than the claims of copending '970. Copending claim 1 of '970 teaches a product comprising an applicator other than a porous or absorbent sheet, which is a puff, pad, sponge, cotton ball, swab, brush, glove, mitt or bar. Said applicator has a wax phase applied (this anticipates **instant claims 1, 20, and 27**). Even though the instant claims are broader than the claims of copending '970, copending claims anticipate instant claims 1-31 because the specified products taught

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by both sets of claims include puffs, pads, sponges, cotton balls, swabs, brushes, mitts, or bars are made of the same liquid and aqueous phase materials.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's Arguments

Applicant argues in the response filed 02/25/2009 that as the copending applications are still pending, Applicant's keep the decision with respect to the obviousness type double patenting rejections in abeyance until there is further clarity with respect to what claims will be granted in the present application.

Response to Arguments

Applicant's arguments have been noted. However, since applicant has not substantially traversed the instant rejection, the rejection is maintained for the reasons of record. Thus, obviousness-type double patenting rejections over copending application numbers 10/520,952 and 10/520,970 are maintained.

Conclusion

No claims allowed. All claims rejected. No claims objected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is (571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611